Remarks/Arguments

This Amendment is submitted in response to the Office Action taken on July 9, 2009 respecting the above-identified U.S. Patent Application.

In that Action, the Examiner rejected all claims in the application as being unpatentable, effectively, over different proposed combinations of U.S. Patent Application Publication No. 2003/0048473 A1 of Rosen (an earlier cited and applied, single, principal reference), U.S. Patent No. 7,430,736 B2 to Nguyen et al. (a newly cited and applied reference), and the general state of the known prior art. The earlier application of the Rosen reference to reject applicant's claims in the immediate prior history of the prosecution of this case has been overcome.

Applicant has carefully reviewed the Examiner's Action and specific comments, along with the previously applied art and the newly cited and applied Nguyen et al. reference, and by the present Amendment, (a) with no addition of any new matter, makes modest changes in language presented at certain points in the specification and in several claims, and (b) points out (1) why the prior-art reference combination proposed by the Examiner is not appropriate, i.e., *not permissible*, (2) why, in any event, there is nothing in the cited art which suggests or leads to such a combination, and (3) why, even allowing (for argument's sake) the appropriateness of that proposed combination for any purpose, the resulting combination *does not produce applicant's claimed invention because of the fact that claimed elements of that invention are completely missing from the cited art.*

Applicant's claimed invention, as discussed in applicant's supporting

specification, involves a methodology which is based upon the presence, within the firmware of an imaging device, of embedded collections of *plural drivers*, and *plural, respectively paired, driver-specific-associated configuration informations*. These paired collections, one each, are specifically designed for operational compatibility, as appropriate, with different, particular client devices that are characterized with different operating systems. The paired components of information are referred to now simply herein as associated, driver/configuration-information "pairs", and the opening paragraph in the specification has been amended herein to introduce specifically "associated pair" foundational language.

Among the key steps of applicant's claimed invention are (a) *automatic client-device requesting* of a download of the appropriate one of such "pairs", (b) *automatic downloading* of the appropriate "pair" (*driver and configuration information*), and (c) thereafter, *automatic configuring* of the downloaded driver in relation to the downloaded pair. These steps, of course, take place in the setting of an imaging device possessing firmware with the embedded *driver/configuration-information* of the character mentioned just above, and clearly identified in applicant's claims.

Missing from the cited and applied prior art, and therefore not attainable by any combination thereof, no matter the impropriety of such a combination, are not only the imaging-device, *paired-collection setting* just expressed, but also *each* of the just identified, invention-including *key steps*.

As the Examiner recognizes, or should recognize, the Rosen reference is wanting in all of the above-highlighted, key aspects of applicant's invention. To begin with, there is no

"firmware-enriched", paired driver/configuration-information-containing imaging device anywhere in the picture. Rosen, at best, focuses only on *single driver (alone)* transference from an imaging device to a client device. *No mention is made of related configuration information.* Accordingly, there is (a) no client-device requesting of appropriate "paired" driver/configuration-data information from a collection of plural, "paired", such informations, (b) no automatic downloading of such paired information, and (c) clearly no resulting, automatic configuring of a downloaded (single) driver.

What the Examiner apparently does not recognize is that these same statements of prior-art deficiency apply equally to the newly cited and applied Nguyen et al. reference. There is (1) no disclosure or suggestion in this reference *that a client device automatically requests any form of downloading* (more will be said about this issue shortly), (2) no disclosure or suggestion *that configuration information is paired with drivers which may be downloaded*, (3) in fact, no disclosure or suggestion at all about configuration information, and (4) no disclosure or suggestion, accordingly, *that auto-configuring of a downloaded driver takes place, or even may take place.* Discussion in the reference about "utilities" is mistakenly treated by the Examiner as discussion about configuration information, and as those skilled in the art well know, this is incorrect. Utilities (utility files) are other things, and in the definitional language provided by Nguyen et al., include "software installation program" material, "fonts", and "monitoring programs" -- typical of what are normally recognized to be included in the realm of "utilities". Further, driver *"installation"* does not mean *auto-configuring.*

Accordingly, even assuming that all other factors are correct and permissible for

combining Nguyen et al. with Rosen, such a combination cannot produce applicant's claimed invention.

Also not recognized, perhaps, by the Examiner is the fact that this reference proposes a decidedly backward step in relation to driver handling. Nguyen et al. focuses expressly on *manual* rather than on *automatic* operation. There is no client-device driver, etc. requesting activity performed by the system and methodology of this reference. Additionally, nothing involving driver activity in the practice *featured* by this patent is in any way automated. The Nguyen et al. practice is, in fact, and clearly in relation to applicant's fully automated behavior as claimed, *regressive*, rather than *progressive* and *advancing*, in nature. One skilled in the art seeking to make an improvement would hardly consider replacing Rosen's *computer-implemented* driver downloading (when driver downloading is done) with *manual* downloading.

On this special point about replacement, one must note, *with recognized concern*, that such a replacement -- the very replacement suggested by the Examiner as being obvious -- would be not only regressive, but also *damaging and destructive* of Rosen's intended function of *computer-based* downloading. This fact alone raises and waves the warning banner of combinational impropriety.

The proposed combination is simply not permissible under both the law and the long-adhered-to, traditional rules involving the proposed combinations of references. The "apparent reason to combine" [*KSR Int'l Co. v. Teleflex, Inc., 550 U.S. 398 (2007)*] here, as suggested by the Examiner, is certainly missing where the proposed combination is *regressive* in the art. Nor in the Examiner's obviousness rejections and his comments about them is there any

RESPONSE TO OFFICE ACTION UNDER 37 C.F.R. § 1.111 for Serial No. 10/763,665; Attorney Docket No. J-SLA.1378

hint of employment of the "useful insight" of locating a *demonstration in the prior art* of a teaching, suggestion or motivation [*KSR Int'l Co. v. Teleflex, Inc., 550 U.S. 398 (2007)*] to implement the proposed (and herein regressive) prior-art combination.

Thus, the cited and applied art (a) is sorely wanting in claim-rejection substantive content, (b) cannot produce applicant's claimed invention no matter how combined, and (c) is not, in any event, properly combinable under the law and/or the traditionally recognized fair practice respecting the uniting of different references. Not only all of this, additionally, there is nothing in the art which *insightfully* leads to the making of a regressive, or backward-going, reference combination as is suggested in the current Action.

The change proposed in paragraph [0004] in the specification simply provides an early statement emphasizing that applicant's invention involves single-event activity.

Looking briefly at the claim changes proposed by the present Amendment, claims 1, 2 and 5 have been modestly currently amended (a) to stress the fact of automatic, *client-device requesting* of a driver/configuration-information pair download, and (b) to make clear that requested downloading is *automatic* rather than *manual*, claims 3, 4, 6 and 7 remain as original claims, and claims 8-17, inclusive, have been canceled without prejudice. All of the changes presented in currently amended claims 1 and 2 carry through into all of the other, ultimately dependent claims (3-7, inclusive).

For the reasons stated above, with entry of the present Amendment, all claims thereafter presented in this application are clearly distinguishable over anything shown or suggested by the cited and applied prior art, and are therefore patentable. Accordingly, favorable

reconsideration of these claims, and early allowance thereof, are respectfully solicited. If the

Examiner has any questions regarding the amendment or remarks, the Examiner is invited to

contact Attorney-of-Record Jon M. Dickinson, Esq., at 503-504-2271.

Provisional Request for Extension of time in Which to Respond

Should this response be deemed to be untimely, Applicants hereby request an

extension of time under 37 C.F.R. § 1.136. The Commissioner is hereby authorized to charge

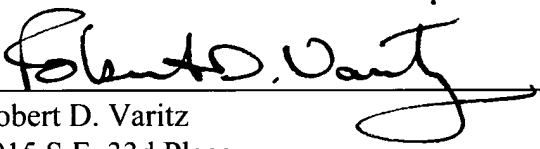any additional fees which may be required, or credit any over-payment to Account No. 22-0258.

Customer Number   Respectfully Submitted,

55428   ROBERT D. VARITZ, P.C.

Registration No: 31436   Robert D. Varitz
Telephone: 503-720-1983   4915 S.E. 33d Place
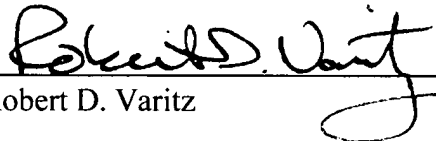Facsimile: 503-233-7730   Portland, Oregon 97202

CERTIFICATE OF EXPRESS MAILING

"Express Mail" Mailing Label No.   EM404027662US
Date of Deposit - September 21, 2009

    I hereby certify that the attached Response to Office Action under 37 C.F.R. § 1.111 is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to:

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Washington, D.C. 22313-1450

Robert D. Varitz